

REMARKS

Claims 1-38 are pending. By this Amendment, claims 7, 8, 29-32, 35 and 36 have been amended. Claims 37 and 38 have been added. No new matter is involved.

Support for new claims 37 and 38 is found through Applicants' disclosure including, for example, on page 18, lines 2-10.

Initially, Applicants acknowledge with appreciation the courtesies extended by Examiner O'Neill to Applicants' undersigned representative, Mr. Webster, during the personal interview conducted on October 21, 2003. During that interview, Applicants' undersigned representative and Examiner O'Neill came to agreement concerning Applicants' traversal of the rejections of record based on 35 USC §112, second paragraph and 35 USC §§102 and 103 based on U.S. Patent 6,041,067 to Takanori.

The remarks set forth in this Amendment constitute Applicant's summary of the aforementioned Interview.

Applicants continue to traverse the holding of lack of unity/restriction requirement. Claims 1-15 recite "a game machine", which is a combination invention, not a subcombination invention. Applicants have the right to claim what they regard as their invention and they regard their invention as a game machine. Moreover, claims 5 and 6 include a display section in addition to the game machine features recited in claim 1; claim 7 includes a game controller in addition to the game machine features recited in claim 1, claim 9 includes a player platform in addition to the game machine features recited in claim 1, and claim 10 includes a player platform in addition to the game machine features recited in claim 4.

Applicants do not understand the last sentence of the paragraph bridging pages 2 and 3 of the Office Action, which states, in part, "group 1 being a combination." Moreover,

compliance with the requirements of MPEP §806.05(c) is a non-issue because the holding of lack of unity never addresses the issue discussed in that section.

The "second" paragraph, which bridges pages 3 and 4 of the Office Action, concerns another non-issue, i.e., whether the subject matter of claims 13-15 is properly restrictable from the subject matter recited in claims 16-18. That issue was not raised by Applicants. Applicants merely pointed out that the Invention of Group II was not what it was alleged to be. That issue is simply not addressed in the holding of lack of unity of invention.

The "third" paragraph, found on page 4 of the Office Action, incorrectly states that the issue of lack of unity is never reached and thus the PCT rules for lack of unity do not apply. The rules of Lack of Unity of Invention apply to all applications filed under the Patent Cooperation Treaty, as required by 35 USC §372(b)(2) and 37 CFR 1.499.

In order to explain why PTO Restriction Requirements for applications filed under 35 USC §111(a) do not override the requirements of MPEP §1893.03(d), including 37 CFR §1.499, a consideration of the history of PCT lack of unity of invention practice is in order.

In 1978, when the United States adopted the Patent Cooperation Treaty, it changed 37 CFR 1.141 to bring U.S. Restriction practice a little bit closer to Unity of Invention practice. 37 CFR 1.141(a) was changed to provide that while two or more independent and distinct inventions may not be claimed in one national application (filed under 35 USC 111), more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that the application also includes an allowable claim generic to all the claimed species, and all the claimed species in excess of one are written in dependent form (per 37 CFR 1.175) or otherwise include all the limitations of the generic claim. 37 CFR 1.146 was also changed to indicate that restriction practice concerning an application having a generic claim and claims directed to more than

one species must permit applicant to claim a reasonable number of species, i.e., restriction is only proper if the application contains claims to more than a reasonable number of species.

That was the only change in restriction practice for applications filed under 35 USC 111. For example, restriction/election of species requirements in U.S. domestic practice (in applications filed under 35 USC 111) were not changed. This was made clear in the O.G. Notice that was issued when the U.S. adopted the Patent Cooperation Treaty. See the treatment of Unity of Invention and implementation thereof in International Applications in the Official Gazette Notice of April 28, 1987 reprinted in the January 7, 1992 Consolidated Listing of O.G. Notices appearing at 1134 O.G. 196+, especially pp. 197+ - which points out the applicability of Genus-Species restriction practice to lack of Unity of Invention determinations in International Applications.

Further evidence of this is found in MPEP Appendix AI, Annex B, Part I, page AI-31, which sets forth guidance on PCT Rule 13 and its applicability to situations where a generic claim is not found allowable. In particular, it points out that:

If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of prior art) may be raised. Similar considerations apply in the case of a genus species or combination/subcombination situation.

The Office was forced to change its restriction practice further, as a result of the Caterpillar case, for National stage applications filed under 35 USC 371(c). This change was codified in 37 CFR 1.475-477 in 1987. This change relates to situations where an applicant presents claims drawn to different statutory classes of invention.

The basis for lack of unity of invention determinations changed even further in applications filed under 35 USC 371(c) when, in May 1993, 37 CFR 1.475 was changed, based on a corresponding change in PCT Rule 13, in January 1993. That change to 37 CFR 1.475(a) made it clear that an international and a national stage application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). The requirement of unity of invention is met when there is a technical relationship among those inventions involving one or more of the same or corresponding **special** technical features. The expression "**special** technical features" means those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the **prior art**.

The amendments to 37 CFR 1.475(a) did change the ground rules with respect to claims directed to different statutory categories of invention, which are found in 37 CFR 1.475(b). This is reflected in 37 CFR 1.475(c) which notes that if an application contains claims to more or less than one of the combinations of categories of invention set forth in 37 CFR 1.475(b), unity of invention might not be present. In other words, an application may contain claims to a product and a process specially adapted for manufacturing that product but, if the product claims and the process claims do not contain any commonly recited **special** technical features, i.e., the only commonly recited technical features are unpatentable over prior art, the claimed inventions in that application lack unity of invention.

Thus, it is clear that there is a fundamental difference between U.S. restriction practice pertaining to applications filed under 37 CFR §111(a), which does not require a search of prior art, and applications filed under the PCT, which does require a search of prior art when there are commonly recited technical features among the claims, and the U.S. restriction practice guidelines do not override the explicit requirements of PCT Lack of Unity of Invention Practice.

Turning to the PCT Lack of Unity of Invention requirements, one must begin an evaluation of the unity of invention issue in terms of the independent claims. See PCT Administrative Instructions, Annex B, which are found in MPEP Section AI, pages AI 38-AI 53. Each independent claim in each different group must be evaluated to determine if those independent claims recite one or more common "special" technical features. A technical feature is "special" if it defines over the prior art. This is a fundamental difference between PCT Lack of Unity of Invention practice and U.S. restriction practice in applications filed under 37 CFR 1.111(a).

Furthermore, in the outstanding Office Action, the attempt to rely on a search report to make out a prima facie case of unpatentability of commonly recited technical features belies the Administrative Procedures Act's fundamental procedural and substantive due process requirement to require a Patent Examiner to make out a prima facie case for any and all rejections and objections, and restriction and unity of invention holdings and requirements.

In similar circumstances, the European Patent Office does not assume that claims have no special technical features for Lack of Unity purposes even when the International Search Report indicates lack of novelty or lack of inventive step "with a view to giving applicant fair treatment." See the attached EPO Board of Appeals decision in this regard. In the attached EPO Board of Appeals decision, the International Search Authority (ISA) based its provisional opinion on the disclosure of a specific United States patent. However, the invitation to pay additional search fees contained no reasoning to support what is in fact a mere allegation of lack of novelty by the ISA.

The Office Actions in this Application simply do not make out a prima facie of lack of unity and do not give Applicants fair treatment in the sense of according Applicants fundamental procedural and substantive due process.

Lastly, the assertion that there would be an undue search burden to search the inventions recited in the Groups corresponding to withdrawn claims 13-24 is completely at odds with the fact that what is recited in the body of those claims is also recited in the body of the elected claims.

What we have in this case is an exalting of form over substance applied on an inconsistent basis. On the one hand, the Office contends that a preamble which recites "a game machine" is anticipated by a reference which does not disclose a game machine other than by stating that certain media can be used in a game machine, whereas on the other hand, lack of unity of invention is based solely on the claim preambles.

Applicants appreciate the production responsibilities of Examiners but do not think that Applicants should be subjected to overly formalistic holdings of lack of unity of invention which focus on claim preambles which are effectively not given weight in the rejection of claims on their merits. This is fundamentally unfair to Applicants and denies them procedural and substantive due process to which they are entitled under the Administrative Procedures Act.

Accordingly, the holding of lack of unity should be withdrawn and all pending claims examined on their merits.

The Office Action rejects claims 7, 8, 11, 12, 29-32, 35 and 36 under 35 USC 112, second paragraph for lacking proper antecedent basis. This rejection is respectfully traversed.

Claims 7 and 8 have been amended to change "the controller" to "the game controller" for which antecedent basis is found in line 2 of each claim as filed. Such was clear on its face in the claims as filed.

Regarding claims 11 and 12, please note that both claims 11 and 12 positively recite, in their preambles, the language "further comprising an optical signal output section." These

positive recitations provide clear antecedent basis for the language "the optical signal output section" in the body of claims 11 and 12.

Regarding claims 29 and 30, these claims have been amended to change "the display section" to -- a display section--, thereby obviating the rejection.

Regarding claims 31 and 32, these claims have been amended to change "the controller" to --a controller--, thereby obviating the rejection.

Regarding claims 35 and 36, these claims have been amended to change "the optical signal output section" has been changed to --an optical signal output section--, thereby obviating the rejection.

Accordingly, Applicants respectfully submit that claims 7, 8, 11, 12, 29-32, 35 and 36 fully comply with the requirements of 37 CFR 112, second paragraph, and request withdrawal of this rejection. Applicants also respectfully submit that the scope of the amended claims (7, 8, 29-32, 35 and 36) has not been narrowed in any aspect by the Amendment.

The Office Action rejects claims 1-8 and 25-32 under 35 USC 102(e) as anticipated by U.S. Patent 6,041,067 to Takamori et al. (hereinafter, "Takamori"). This rejection is respectfully traversed.

In order to anticipate a claim, all features or limitations of a claim must be disclosed in a single reference either explicitly or inherently. See, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

All positively recited features of a claim must be addressed in an Office Action, In re Angstadt et al., 190 USPQ 214 (CCPA 1976); In re Alul et al., 175 USPQ 700 (CCPA 1972); and General Electric Company v. U.S., 198 USPQ 65 (US ClCt 1978).

The first feature addressed in the rejection is the preamble, which recites "a game machine." Takamori does not disclose a game machine, per se. All that Takamori discloses regarding a game machine is that "[T]ypical multimedia packages are video CDs and CD-ROMs from which video and audio information can be reproduced using game machines or personal computers." Just mentioning game machines can be used falls far short of disclosing a game machine. Takamori does disclose a DVD player, but not a game machine.

In col. 1, lines 48+, in describing Fig. 13, Takamori discloses that each frame contains a system clock reference (SCR) 11b, a presentation time stamp (PTS) 11c, and packet data (PD) 11d. The Office Action refers to Fig. 13 and the three aforementioned elements but never states what the Office considers to be the synchronization data. The Office Action does state that packet data 11d contains main-picture and sub-picture data. By process of elimination, applicants conclude that that characterization leaves the SCR and PTS as the synchronization data.

Claims 1 and 25 recite that the synchronization data is included "within at least one of the sound and image data." However, Takamori's synchronization data, i.e., SCR and PTS, is not contained within the video and audio data 11d. Whereas the SCR and PST are included in the "frame", they appear before, not "within" the audio and video data 11d.

Claims 2 and 26, which recite "at least one item of the synchronization data is included within a range of data that is capable of being accessed simultaneously." Takamori does not teach this feature explicitly or inherently. The Office Action never states exactly where this feature is found in Takamori. Instead, the Office Action only states that "[B]ecause clock speeds are in milliseconds, if not short (sic: shorter) depending on the equipment, the accessibility of the data appears virtually simultaneously as understood by those in the art" (emphasis added).

The claims do not recite "virtually simultaneously." The claims recite "simultaneously." The standard for anticipation is not "virtual" anticipation.

Accordingly, Takamori does not anticipate claims 1, 3-8, 25 and 27-32.

The Office Action rejects claims 9, 10, 33 and 34 under 35 USC §103(a) as unpatentable over Takamori. This rejection is respectfully traversed.

The rejection fails to make out a prima facie case of obviousness of the claimed invention for a number of reasons.

The factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness, which are set forth on page 9 of the rejection, are simply not applied with respect to the rejected claims. Because the rejection is based on 35 USC §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. Section 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

This rejection fails to address all of the features recited in claims 9, 10, 33 and 36. The Office Action never states why Takamori is applied, and never addresses the "player platform and the seat." Instead, the body of the rejection states that the type of input and output means for a game machine is an obvious design choice absent a showing of criticality

for the particular input and output means. By failing to address all of the features of the claimed invention, the rejection fails to evaluate the invention as a whole. Thus, the rejection is improper and should be withdrawn.

Moreover, the four steps set forth on page 9 of the Office Action, are not the four factors set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). The fourth factor concerns secondary considerations.

Additionally, a fundamental requirement of a prima facie case of obviousness includes an explanation of why one of ordinary skill in the art would have been motivated to make the proposed modification - a factor not mentioned or addressed in any manner in the rejection.

Regarding making a prima facie showing of obviousness of the claimed invention, the first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

This rejection does not address the issue of motivation and, as such, does not make out a prima facie case of obviousness of the claimed invention.

Unless and until a prima facie case of obviousness has been made, the Applicants need not present any evidence including, for example, evidence of criticality.

Moreover, the rejection does not allege that the prior art (presumably Takamori, which is not discussed at all) may be modified, nor states the manner in which it may be modified, nor how the prior art suggests the desirability of the modification. This must be done as part of making out a prima facie case of obviousness. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir, 1992). Additionally, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Turning to the merits of the rejection, it is clear that Takamori does not disclose or render obvious the features of claim 1, from which claims 9 and 10 depend, or the features of claim 25, from which claims 33 and 34 depend, for reasons presented above. Accordingly, claims 9, 10, 33 and 34 are patentable at least because of the features they recite based on their dependency from claims which patentably differ from Takamori.

Accordingly, the rejection of claims 9, 10, 33 and 34 under 35 USC §103(a) as unpatentable over Takamori is improper and must be withdrawn.

Applicants have added claims 37-38, both of which are patentable because they depend from claims which are patentable for at least the reasons stated above.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Robert J. Webster
Registration No. 46,472

JAO:RJW/sxb

Date: October 22, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--